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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,023	03/23/2001	Joseph G. Englert	539P	8510
7590 02/13/2006				
Thomas M. Freiburger 650 California Street, 25th Floor San Francisco, CA 94108			EXAMINER ALPERT, JAMES M	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/816,023		ENGLERT, JOSEPH G.	
	<b>Examiner</b>		<b>Art Unit</b>	
	James Alpert		3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

The following communication is in response to Applicant's amendment filed on 11/21/2005.

#### ***Status of Claims***

Claims 2-10 are original. Claim 1 is currently amended. Claims 1-10 are therefore currently pending.

#### ***Response to Arguments***

**With regard to the rejections made under 35 U.S.C. 101**, as they relate to technology in the claims, in view of Ex Parte Lundgren, Appeal No. 2003-2088 (BPAI 2005), these rejections are hereby withdrawn.

**With regard to the rejections made under 35 U.S.C. 112**, Applicant's arguments are persuasive, and these rejections are hereby withdrawn.

**With regard to the rejections made under 35 U.S.C. 103**, Applicant's arguments have been fully considered, but they are not persuasive, as discussed below. Claims 1-10 remain rejected, and Applicant's request for allowances is respectfully declined. **With regard to Claim 1**, Applicant advances several arguments in an attempt to distinguish himself from the prior art. Initially, applicant argues that his claims concerns facilitating financing of an export transaction, whereas Walker concerns itself with enabling a buyer and seller to communicate with one another in an export transaction. The examiner disagrees for two reasons.

First, even if it is assumed that applicant's characterization of the two applications is correct, the "concerned with" standard is not the standard to apply in

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determining anticipation. That is to say, the examiner bases the rejections of this claim on the language of the claims, not the ideas in the specification. To that end, as discussed below, the examiner is satisfied that the cited portions of Walker sufficiently describe Applicant's claims as they presently stand.

Second, the examiner disagrees with the characterization of the Walker reference. The examiner views the Walker reference as a multi-step process. The buyer and seller can both undertake to enter information onto forms, in order to determine the terms of the agreement for the transaction. Assuming that each party views the agreement as beneficial upon analysis of the input information, the transaction proceeds to a final invoice and contractual obligations. See the Walker "SUMMARY OF THE INVENTION" at (Walker, Paras. 45-59).

Applicant next argues several points of the sub-steps of Claim 1. Before addressing each point, Applicant is reminded that claims may be given the broadest reasonable interpretation. In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). In terms of step (a) of Claim 1, Applicant argues that there is no mention of time frame of delivery in the cited passage of (Walker, Paras. 82-84). The examiner disagrees. Walker specifically says that the earliest possible shipping date is provided information to the parties. In terms of step (b), Applicant argues that Walker does not teach the point where risk of loss shifts. To the contrary, Walker points out that a specific Incoterm will be agreed to. Applicant argues that Walker does not teach financing tools as described in (c3), but again, the examiner disagrees. (Walker, Para. 99) discusses credit cards, letters of credit, currency, escrow arrangements, and drafts.

To the extent that multiple credit card systems (Visa, AmEx, Discover, etc) are made available, simple credit card availability would sufficiently anticipate this limitation.

Applicant next argues steps (c1) – (c5). Applicant begins by arguing the incorrect notion that there are differences in concept of what the inventions are supposed to “be about.” It is what is claimed that is paramount, as discussed above. In terms of (c2) and (c3), Applicant argues that Francis does not teach structural and transactional costs. The examiner disagrees. Francis discusses fees, commissions, charges, and presumably other costs that are involved in the transaction that are specific to the individual transaction contemplated by the parties. Francis points out that other terms and costs will be produced by those skilled in the art. Further, at (Col. 11, line 53 – Col. 12, line 21), Francis discusses a form for financing options including letters of credit, banks, etc, along with detailed financial information, presumably including pre-import and post-export costs. The examiner is satisfied that Francis reads on a broad interpretation of this section of Claim 1.

Steps (c4) and (c5) claims a cost ratio comprising total structural and transaction costs divided by transaction amount. The examiner took notice that this is old and well known in the art. Applicant has argued that the above-described ratio has not been used in export transaction financing previously. Without discussing the merits of this assertion, the examiner would point out that this is the incorrect standard. The examiner must show a ratio of this type is old and well known, and then must show that it would be obvious to apply the ratio in an export transaction. Further, MPEP §2144.03(C) states, in respect to an Examiner’s use of Official Notice:

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To adequately traverse such a finding [of official notice], an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b).

The same section continues:

If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate.

Although Applicant has asked for evidence of the noticed facts, eg a reference, he has not stated his opinion as to why the noticed fact in steps (c4) and (c5) is not considered to be common knowledge or well-known in the art. Thus, Applicant's traversal is technically inadequate, and the cost/amount ratio can be deemed admitted.

Still, in response to applicant request for a reference, the Applicant would point out that the ratio described is nothing more than a profit margin. For example, automobile dealers buy vehicles from a manufacture and then resell to the public. Thus they have structural and transaction cost in any purchase of cars. As well, the transaction amount would be the total sales revenue for one or more vehicles. If 5 cars are purchased by a dealer for \$100,000 and sold to the public for \$125,000, the ratio is 4/5 or .80. Clearly the lower the ratio, the better. Thus this ratio is nothing more than profit margin. The applicant will observe that the examiner pointed out this fact when arguing the motivation to include the ratio would help to insure profitability among parties to the transaction. The examiner would ask applicant to consider the "Lithia Motors, Inc., Reports ... (PR Newswire, October 28, 1998)", which discusses vehicle profit margin extensively, and particularly, the 4<sup>th</sup> through 6<sup>th</sup> full paragraphs. Thus, the

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noticed fact is substantiated, and the rejections of these steps of Claim 1 are maintained.

Claim 9 is properly rejected alongside claim 1 as a system and method. The noticed fact of Claim 10 is not traversed and is deemed admitted. In summary, the rejections of the previous office action are maintained as follows:

***Claim Rejections - 35 USC § 103***

The text of 35 U.S.C. §103, which is not included in this action, can be found in a prior Office action. Claims 1-10 are rejected under §103 as being unpatentable over Walker et al, U.S. Patent Application Publication #20020095355, in view of Francis et al, U.S. Patent #6772131.

**With regard to Claims 1,9,** Walker teaches the system and method comprising:

(a) entering onto an inquiry form:

information regarding the exporter/customer, information on the buyer in the proposed transaction, and (Paras. 66-67)

information on the goods to be sold, terms of sale and the price to be paid for the goods to be exported to the buyer, and the time frame for delivery; and also (Paras 82-84)

entering method of payment information and (Para. 98)

information concerning the financing needed for the transaction, (Para. 104)

(b) evaluating risks of the transaction, including:

risks attendant to the nature of the particular transaction and (Paras. 22-23,45,72-74,81)

to the point at which risk of loss passes to the buyer, (Paras. 78-79)

risk involved in obtaining payment to the exporter/customer, and risks attendant to financing of the entire transaction, (Paras. 81,98-99)

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(c) entering information into a solution work sheet, information including

the time duration between initiation of the transaction and shipment, (Para. 100)

and the time duration from shipment until projected final payment for the goods exported, (Paras. 98-100)

incoterms for the transaction, and the time at which risk of loss passes to the buyer, (Paras. 78-79)

(c1) using a list of financial tools to review possible pre-export and post-export credit tools for financing the export transaction, (Para. 99)

Walker does not expressly teach the remaining limitations of Claim 1. However, Francis does disclose the following:

(c2) entering information on a financial tool price sheet, as to the structural cost and the transaction cost of using each of a plurality of pre-export tools listed on the list of financial tools, and a plurality of post-export tools listed on the list of financial tools, and determining lender revenue for each of the various alternatives, (Col. 6, lines 12-17)

(c3) selecting appropriate financing tools for the transaction, both pre-export and post-export, and entering projected structural costs and transaction costs on the solution work sheet as tentative costs for a course of action using the selected tools, (Col. 11, line 53 – Col. 12, line 21)

It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to modify the teachings of Walker relating to a method of for analyzing an export transaction with the teaching of Francis relating to a method for inputting financial data in a working format. The motivation for such a combination is found in Walker at (Paras. 22,26,35) which describes the importance of knowing all the cost involved in an export transaction, and how to use computer technology to assist in the process.

Walker does not teach the remaining limitations, namely:



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(c4) determining a total cost ratio for the financing of the transaction, calculated as total costs including structural and transaction costs, divided by the total transaction amount, the total cost ratio serving as a cost management device and a cost tracking mechanism, and

(c5) evaluating the overall cost ratio, and if it appears reasonable for the transaction, preparing a term sheet which contains a finance proposal for the export transaction.

However, the cost ratio is a statistical tool that is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to modify the teachings of Walker relating to a method of for analyzing an export transaction to include the cost ratio. The motivation for such a combination is found in Walker at (Paras. 22,26) which describes the importance of knowing all the cost involved in an export transaction, so as to ensure profitability. The cost ratios are critical to these determinations.

**With regard to Claim 2, Walker teaches the method comprising:**

... if the customer/exporter and a lender agree on the finance proposal, preparing an accepted finance plan, including action steps and dates and outlining the pre-export and post-export portions of the transaction and giving the lender basis for a written financing offer. (Paras. 99-100)

**With regard to Claim 3, Walker teaches the method wherein:**

wherein the step of evaluating risk of the transaction includes entry of all pertinent information on a risk evaluation sheet divided into pre-export and post-export sections. (Para. 35)

**With regard to Claim 4, Walker does not expressly teach the method wherein:**

if the total cost ratio seems unacceptable for the transaction, reiterating steps c1 through c5 using different financial tools from the list of financial tools, with entry of different costs onto the solution work sheet, in an attempt to obtain a better total cost ratio.

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However, this limitation is an obvious extension over Claim 1, in that if the cost ratio calculated in Claim 1 is found to be deficiently large or otherwise problematic, the only solution is to attempt different financial tools available. This claim is rejected under the same analysis as Claims 1(c4-c5).

**With regard to Claim 5,** Walker teaches the method comprising:

including an additional step (d) of entering information on actual costs of the financing transaction as the transaction goes forward, onto a cost comparison sheet on which actual items of cost and actual total cost can be compared against costs determined in steps c2 through c5. (Paras. 108-109)

**With regard to Claim 6,** Walker does not expressly teach:

calculating an actual cost ratio and comparing the actual cost ratio to the overall cost ratio determined pursuant to step c4.

However, the cost ratio is a statistical tool that is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to modify the teachings of Walker relating to a method for analyzing an export transaction to include both theoretical and actual cost ratios. The motivation for such a combination is found in Walker at (Paras. 22,26) which describes the importance of knowing all the cost involved in an export transaction, so as to ensure profitability. The cost ratios are critical to these determinations. If anything goes peculiarly wrong, a mid-course correction can be made. See (Para. 109) as well.

**With regard to Claim 7,** Walker teaches the method further comprising:

exporter costs with lender revenue broken out separately, and (Para. 49)

including entry of actual costs and revenue as determined from the actual transaction cost review sheet onto an actual ratio comparison sheet, and (Paras. 108-109)

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further entering projected costs and revenue onto the actual cost ratio comparison sheet, and comparing the actual and projected costs and revenue, including comparison of actual and projected overall cost ratio for the transaction. (Paras. 108-109)

**With regard to Claim 8**, Walker teaches the method further comprising:

evaluating performance risks of the exporter/customer, related to the payment record of the exporter/customer. (Para. 81)

**With regard to Claim 10**, Walker does not teach the system wherein:

the cost ratio work sheet includes spaces and prompts for entry of projected lender revenue and a projected total lender revenue ratio.

However, a cost ratio work sheet including lender revenue is part of an old and well-known statistical process. It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to modify the teachings of Walker relating to a method for analyzing an export transaction to include both theoretical and actual cost ratios. Calculating lender revenue would be inherent to they system of determining the ratio. The motivation for such a combination is found in Walker at (Paras. 22,26) which describes the importance of knowing all the cost involved in an export transaction, so as to ensure profitability. The size of the lender revenue has a big impact on the overall ratio, and would influence the costs of conducting the transaction.

### ***Conclusion***

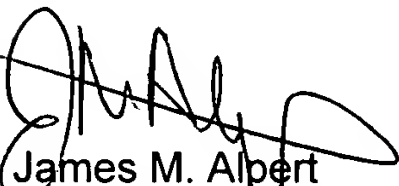
THIS ACTION IS FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened

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statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Alpert whose telephone number is (571) 272-6738. The examiner can normally be reached on M-F 9:30-6:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.



James M. Alpert  
January 31, 2006



HANI M. KAZIMI  
PRIMARY EXAMINER